



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1614
TECH CENTER 1600/2900

OCT 10 2002

RECEIVED

In re the Application of:

COLACCI et al.

Art Unit: Unknown

Application No.: 09/926,286

Examiner: Unknown

Filed: January 15, 2002

Attorney Dkt. No.: 100506-00004

For: THE USE OF ALPHA LIPOIC ACID IN THE ANTIMETASTATIC TREATMENT

**PETITION TO RESTART PERIOD FOR RESPONSE TO OFFICE ACTION AND TO
WITHDRAW ANY HOLDING OF ABANDONMENT**

Commissioner for Patents
Washington, D.C. 20231

Date: October 8, 2002

Sir:

Applicants petition that any Notice of Abandonment mailed from the U.S. Patent and Trademark Office to the firm of Arent Fox Kintner Plotkin & Kahn, PLLC (referred to herein as "Arent Fox") regarding the Office Action dated February 25, 2002 be withdrawn. It is also petitioned that the Office Action be remailed and that the period for Response be restarted.

In a recent telephonic interview, the Examiner indicated that an Office Action in the above application was mailed on February 25, 2002. Yet, no such Office Action was ever received by the Arent Fox firm. Attached are Declarations by Mr. Philip Austin (the docket clerk for the Arent Fox firm on August 25, 2002, Mr. Robert B. Murray (a partner in the Arent Fox firm and the attorney on the case), and Cynthia Brooks, (Mr. Murray's secretary) detailing the mail-handling and docketing procedures for the Arent Fox firm, and detailing the reasons why it is apparent that no Office Action for the above

application was ever received by the Arent Fox firm. As of this date, we still do not have a copy of any such Office Action.

It is noted that any presumption that mail matter properly addressed, stamped and deposited in an appropriate receptacle is duly delivered is predicated on the fixed methods and systematic operation of the Postal Service, and that such a presumption can be rebutted. See Legille v. Dann, 544 F.2d 1 (CAFC 1976).

The effectiveness of the correspondence address has been demonstrated by Applicants' representative's receipt of the Notice of Recordation of Assignment dated March 22, 2002 (copy attached). The applicants' contention of non-receipt of the Office Action allegedly mailed February 25, 2002 is supported in the enclosed Declarations. Thus, it is respectfully submitted that the failure of the February 25, 2002 Office Action to reach the Arent Fox firm was not the fault of the Arent Fox firm in any way.

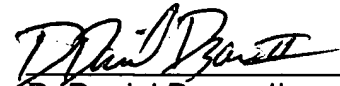
It is respectfully requested that the Office Action be remailed to the Arent Fox firm and that any holding of abandonment be withdrawn. See MPEP § 711.02 and Delgar Inc. v. Schuyler, Commr. Pats, 172 USPQ 513 (D.D.C. 1971).

Should withdrawal from abandoned status not be granted immediately, this Petition should be considered to be a Petition to the Commissioner under 37 C.F.R. 1.181 - 1.183, including a petition that all fees in connection therewith be waived because it is clear that the applicants are not at fault in this matter.

Should any such petition Under 37 C.F.R. 1.181 - 1.183 not be immediately granted, this Request should be considered to be a Petition under (37 C.F.R. 1.137(a) or 1.137(b)), including a petition that all fees in connection therewith be waived because it is clear that the applicants are not at fault in this matter.

The Commissioner is authorized to charge payment for any additional fees that may be required with respect to this paper to our Debit Account No. 01-2300, referring to client-matter number 100506-00004.

Respectfully submitted,



D. Daniel Dzara, II
Registration No. 47,543

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
1050 Connecticut Avenue, N.W.,
Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810

Copies of the following documents are enclosed:

Declaration of Philip Austin
Declaration of Mr. Robert B. Murray
Declaration of Cynthia Brooks
Appendix A
Appendix B
Notice of Recordation of Assignment



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In re the Application of:

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Art Unit: Unknown

Application No.: 09/926,286

Examiner: Unknown

Filed: January 15, 2002

Attorney Dkt. No.: 100506-00004

For: THE USE OF ALPHA LIPOIC ACID IN THE ANTIMETASTATIC TREATMENT

DECLARATION

Commissioner for Patents
Washington, D.C. 20231

Date: October 8, 2002

Sir:

I, Philip Austin, a citizen of the United States, hereby declare and state:

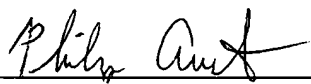
1. I am the docket clerk at the firm of Arent Fox Kintner Plotkin & Kahn, PLLC, (referred to herein as the firm).
2. As the docket clerk at the firm at that time, my duties include following the docketing and USPTO filing procedures for the firm, including reviewing all mail received from the USPTO and docketing all due dates created by that mail in the Master Docket, which I maintained in the manner described in the Appendix attached to the Declaration by Mr. Robert B. Murray.
3. Upon examining the Master Docket after receiving the Notice of Abandonment in the above application, I noted that the Master Docket contains no notation of any due date for responding to a February 25, 2002 Office Action in the above application.

4. I have been instructed on the importance of ensuring that the Master Docket reflected every due date established by mail received by the firm from the USPTO.

5. I am not aware of any occurrence where an Office Action (in an application where the applicant has not instructed us to abandon the application) was mailed to the firm and received by the firm, but was not docketed in the Master Docket.

6. Based on the above, it is my belief that the Office Action concerning the above application was never received by the firm.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Philip Austin

10/8/02
Date



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

COLACCI et al.

Art Unit: Unknown

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Attorney Dkt. No.: 100506-00004

For: THE USE OF ALPHA LIPOIC ACID IN THE ANTIMETASTATIC TREATMENT

DECLARATION

Commissioner for Patents
Washington, D.C. 20231

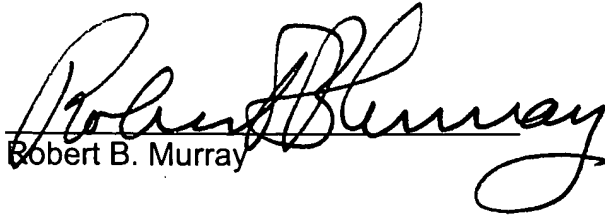
Date: October 8, 2002

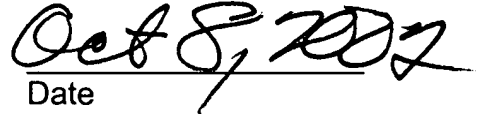
Sir:

I, Robert B. Murray, a citizen of the United States, hereby declare and state:

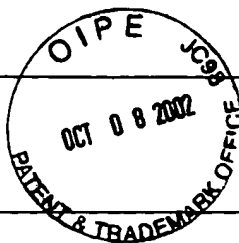
1. I am a partner in the firm of Arent Fox Kintner Plotkin & Kahn, PLLC
(referred to herein as the firm).
2. Attached hereto is an APPENDIX, which is a true rendition of the general procedures for the firm with regard to docketing due dates created by mail received from the U.S. Patent and Trademark Office (USPTO).
3. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under

Section 1001 Title 18 of the United States Code and that such willful false statements
may jeopardize the validity of the application or any patent issued thereon.


Robert B. Murray


Date

Enclosure: APPENDIX



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Prosecution Support Departments

The Prosecution Support Departments have been established to provide support to intellectual property attorneys with patent and trademark prosecution practices. The procedures for sending work to the departments are intended to provide a high quality work product in an efficient manner. The procedures are periodically modified to accommodate the needs of the Firm.

The WORK REQUEST form is used to forward work to the Patent Formalities Department, Foreign Filing Department and Word Processing. (Appendix II-1) The WORK REQUEST form provides information for prioritizing the incoming work. Incoming work is prioritized utilizing the following guidelines:

- | | |
|-----|--|
| 1st | by the date the document is due to be filed |
| 2nd | by the desired date |
| 3rd | by the date the work was received in the Department |

It is requested that work be forwarded to the Prosecution Support Departments with at least a 24-hours notice before it is request back, preferably a 48-hours. It is recognized that it is not always possible to give such notice. Every effort will be made to meet every work request in an timely manner. The attorney and/or secretary will be called if a document/project cannot be completed by the desired date.

1. Docketing Department

The Firm has a centralized docketing database that tracks important dates for patent and trademark prosecution files. The Docketing Department is responsible for updating and maintaining the accuracy of the docketing database. The Docketing Department distributes daily and weekly docket reports to the attorneys and secretaries. Special or customized client reports can be requested through the Docketing Coordinator.

The main docket must be reconciled by close-of-business each day. The Docketing Department will call the attorney or secretary with questions about open items on the docket. (See Section 5, Docketing) If you wish to send instructions or information to the Docketing Department via email, address your email to "IP Docketing." This mail box is set up so that all docketing staff are alerted when a message is received.

The Docketing Department has a separate mail room for opening and sorting the incoming prosecution mail and facsimiles. The prosecution mail from the U.S. Department of Commerce and addressed to Suite 600 is pulled from the mail delivered to the Central Mail Room. This mail is delivered to the docketing mail room. It is here that the mail is sorted into categories, stamped and logged in (See Appendix II-2). The mail and facsimiles are given to the docketing staff to docket in the centralized docketing database. The database record is printed and attached to the mail or fax. The database record is reviewed by the attorney and secretary for accuracy. If there are any errors, the marked-up database record is returned to the Docketing Department for correction. The database record is maintained in the file on the right-hand side. (See Section 4, Maintaining, Storing and Retaining the IP Prosecution File)

A U.S. PTO Filings box is located in the Docketing Department. All U.S. PTO filings are put in the box by 3:30 p.m. with the file. Docketing will check the filing and log it in the U.S. PTO filings log. The Docketing Department then delivers the filings to Mail Messenger Services. Mail Messenger Services arranges for the courier to pick up the filings and deliver them to the U.S. PTO and return the stamped postcard receipt. Hand-carries to the U.S. PTO are arranged by Mail Messenger Services upon request. The Docketing Department will update the docketing database from the returned postcard receipt when it is returned with the U.S. PTO stamp. The postcard receipts are maintained in the Docketing Department.

2. Patent and Trademark File Room

A separate file room for patent and trademark prosecution files has been set up to provide support for tracking and storing prosecution files. After the prosecution mail is docketed, the file is pulled from the shelf and scanned out to the responsible attorney and delivered.

If the file is already checked out, the person to whom the file is checked out to and the date it was checked out is written on the upper right-hand corner of the document. The file room will make one attempt to locate the file at the attorney or secretary's desk. Then it is the secretary's responsibility to locate the file if it is checked out to his/her assigned attorney. If the secretary cannot locate the file within a reasonable time, he/she may request that the staff in the Patent and Trademark File Room conduct a search for the file. Regular sweeps of the office are conducted to pick up files being returned to the Patent and Trademark File Room.

The Patent and Trademark File Room also provides a transfer service. Files being transferred to another attorney or department (i.e., Formalities, Foreign Filing, etc.) will be picked up and checked out to the new location in the records management system. The files will then be delivered to the new location. This service is provided when the regular sweep of the office is conducted or by calling the Patent and Trademark File Room (Ext. 5200) or sending an email to a records clerk.

The staff in the Patent and Trademark File Room are responsible for sending and retrieving files from storage. (See Section 4, Maintaining, Storing and Retaining the IP Prosecution File) Requests for files are made by calling the Patent and Trademark File Room (Ext. 5200) or sending an email to one of the records clerks.

3. Patent Foreign Filing Department

The Patent Foreign Filing Department provides expertise and support for foreign patent applications. Some of the responsibilities of the Patent Foreign Filing Department include: providing estimates for filing new cases in foreign countries, preparation and filing of foreign applications, completing formality matters, and attending to foreign annuities.

New cases received in the Patent Foreign Filing Department are assigned by the Coordinator. The Coordinator is responsible for notifying the Docketing Department so that the responsible Patent Foreign Filing Specialist can be added to the docket. The Patent Foreign Filing Specialist is responsible for keeping a backup docket and reconciling his/her backup docket with the main docket each day.

The Patent Foreign Filing Department prepares documents from forms that have been approved by the Firm. All documents are signed by the responsible attorney. Completed work is sent to the "signing room" for signature by the attorney. The Patent Foreign Filing Department is responsible for copying and completing the project after signature.

4. Patent Formalities Department

The Patent Formalities Department provides expertise and support for U.S. patent applications. Some of the responsibilities of the Patent Formalities Department include: filing new U.S. patent applications, filing missing parts, reporting letters, payment of Issue Fees and U.S. Maintenance Fees.

A log of all work received in the Patent Formalities Department is maintained by the staff of the Department. The log also serves as a docket and identifies on any given day the documents that are due to be filed in the U.S. PTO on that date. Reporting letters and items without due dates are prioritized in the order of receipt. It is the Department's goal that all reporting letters be mailed within five business days of receipt in the Department.

The Patent Formalities Department prepares documents from forms that have been approved by the Firm. All documents are signed by the responsible attorney. Completed work is sent to the "signing room" for signature by the

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Washington, DC 20036-5339
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www.arentfox.com

MEMORANDUM

RE: Mail Flow and Docketing

DATE: April 8, 2002

In an effort to create a uniform flow of mail and docketing procedures in the IP Practice, the following procedures will be adopted:

USPTO MAIL

- (1) USPTO Mail will be received in the IP mailroom and will be stamped with the received date. The mail will then be delivered to docketing.
- (2) Docketing will make appropriate docketing entries and have the mail delivered to the responsible attorney no later than noon of the business day following receipt of the mail in the mailroom.
 - (a) U.S. PTO patent mail will be delivered to the Patent Formalities Department with the exception of Notices of Missing Parts or Requirements, 1 or 2 month Office Actions, Advisory Actions, Notices of Allowability and Notices of Allowance.
- (3) The responsible attorney will obtain the file and take appropriate action.
- (4) The responsible attorney can obtain the file from the file room using any of the following file ordering procedures:
 - (a) send an e-mail to the file room;
 - (b) call the file room;
 - (c) carry the Office Action or a copy thereof to the file room and place it in an appropriately designated basket; or

- (d) go into the file room and take the file. **It is mandatory that if a file is taken from the file room, it must be logged out of the file room.**

FACSIMILE AND COURIER MAIL

A. Facsimiles received before 8:00 a.m.

- (1) a. Facsimiles for patent matters received before 8:00 a.m. will be date stamped, copied and logged in the IP mailroom fax log and then placed in the signing room.

b. Facsimiles for trademark matters received before 8:00 a.m. at the IP support fax machine will be date stamped, copied and logged in the IP mailroom fax log and delivered to the responsible attorney.
- (2) Facsimiles in the signing room will be reviewed by partners and noted for distribution.
- (3) The facsimile copies will be reviewed by docketing and docketed where necessary.
- (4) For new applications and other new matters, docketing will attend to the preparation of new case reports, preparation of files, etc.
- (5) The responsible attorney can obtain the appropriate file from the file room using any of the above file ordering procedures.
- (6) FOR ALL MATTERS, THE FACSIMILE CORRESPONDENCE OR A COPY THEREOF, WILL BE GIVEN TO THE RESPONSIBLE ATTORNEY BY 10:00 A.M.

B. Facsimiles received after 8:00 a.m.

- (1) Facsimiles received in the Arent Fox fax room will be distributed in accordance with current Arent Fox procedures.

- (2) Facsimiles received in the IP mailroom, whether from the Arent Fox fax room or directly, will be date stamped, copied and logged in and then distributed to the responsible attorney. The facsimile will be given to the responsible attorney within two (2) hours of receipt in the IP mail room.
- (3) The facsimile copy will be reviewed by docketing and docketed where necessary.
- (4) If the responsible attorney wants to obtain the file, the responsible attorney will obtain the file using any of the above file ordering procedures.

C. Courier Mail

- (1) Courier mail received in the Arent Fox mailroom will be distributed in accordance with current Arent Fox procedures.
- (2) Courier mail received in the IP mailroom or brought to the IP mailroom by the Arent Fox mailroom, will be logged in and date stamped and then given to docketing.
- (3) Docketing will make an appropriate docket entry where necessary and the correspondence will be given to the responsible attorney.
- (4) After reviewing the correspondence, the responsible attorney can obtain the file using any of the above file ordering procedures.
- (5) For courier mail received by the IP mailroom, the IP mailroom will immediately notify the addressee or their secretary by email or telephone of the receipt of the courier package; the package will be delivered to the responsible attorney within two (2) hours of receipt, except for patent matters where new case reports and files must be set up.

D. All Other Mail

- (1) All mail received in the Arent Fox mailroom which does not designate "Suite 400" will be distributed directly to the

addressee in accordance with current Arent Fox mail distribution procedures.

- (2) All mail designating "Suite 400" or which cannot be identified by the Arent Fox mailroom, will be given to the IP mailroom. After logging in and date stamping, the mail will be given to docketing and a docket entry will be made when necessary.
- (3) The mail will then be distributed to the responsible attorney.
- (4) Mail will be distributed to the responsible attorney as soon as possible, but no later than within one (1) day of receipt.
- (5) The responsible attorney will obtain the file using any of the above file ordering procedures.

E. Unidentified Mail

- (1) The Arent Fox mail center will send unidentified mail referencing the terms patent or trademark to docketing. Docketing will attempt to identify the responsible attorney using CPI and Carpe Diem. Docketing will send out an email to all IP attorneys if the responsible attorney can not be identified from CPI or Carpe Diem.
- (2) Docketing will make an appropriate docket entry where necessary and the correspondence will be given to the responsible attorney within one day of its receipt.
- (3) After reviewing the correspondence, the responsible attorney can obtain the file using any of the above file ordering procedures.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

COLACCI et al.

Art Unit: Unknown

Application No.: 09/926,286

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Filed: January 15, 2002

Attorney Dkt. No.: 100506-00004

For: THE USE OF ALPHA LIPOIC ACID IN THE ANTIMETASTATIC TREATMENT

DECLARATION

Commissioner for Patents
Washington, D.C. 20231

Date: October 8, 2002

Sir:

I, Cynthia Brooks, a citizen of the United States, hereby declare and state:

1. I am a secretary at the firm of Arent Fox Kintner Plotkin & Kahn, PLLC (referred to herein as "the firm").
2. Since December 1989, I have been responsible for assisting Robert B. Murray, as a secretary at the firm. The duties of a secretary in connection with being responsible for assisting Mr. Murray include following the docketing and U.S. Patent & Trademark Office ("USPTO") filing procedures for the firm. Mr. Murray is responsible for the above application.
3. Upon examining the personal docket maintained by me as Mr. Murray's secretary, I noted that the personal docket book contains no notation of any due date for response to the Office Action in the above application on May 25, 2002 (i.e., three

months from the alleged date of mailing of the Office Action in the above application).

ATTACHMENT 1 is a true and current copy of the docket book covering May 25, 2002.

4. Upon examining the cover of the file for the above application after receiving the Notice of Abandonment in the above application, I noted that there is no notation of any due date for response to the Office Action in the above application as required by Firm procedure. ATTACHMENT 2 is a true and correct (reduced-size) copy of the cover of the file for the above application.

5. Secretaries at the firm are instructed on the importance of ensuring that personal docket books and the cover of each file reflect every due date established by mail received from the USPTO concerning any application.

6. I am not aware of any occurrence where an Office Action (in an application where the applicant has not instructed us to abandon the application) was mailed to and received by the firm and was not docketed in the master docket and the personal docket book of the secretary responsible for assisting the responsible attorney. There are no instructions from the applicant in this application to abandon this application.

7. Based on the above, it is my belief that the February 25, 2002 Office Action concerning the above application was never received by the firm.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Cynthia Brooks
Cynthia Brooks

10/8/02
Date

Enclosure: ATTACHMENT 1
ATTACHMENT 2

May 2002
S M T W T F S
1 2 3 4
5 6 7 8 9 10 11
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June 2002
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23 24 25 26 27 28 29
30

Saturday May 25

145/220

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p.m. 12:00

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146/219

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7:45

ATA-GLANCE®

BIANCETTI - BRACCO - MINOJA S.r.l.
Studio Consulenza Brevetti

Via Rosini, 8
20122 Milano, Italy

Their Ref: 9423 V/vmf
Fax: 39-02-783078

IT FOX KINTNER PLOTKIN & KAHN, PLLC
1050 Connecticut Avenue, NW
Washington, DC 20036-5339

ATTORNEY: *FBM*

FOREIGN FILING DOCKETED YES ☐ NO ☐ INIT. _____

SMALL ENTITY: _____

ORIG. DOCS IN FILE? YES ☐ NO ☐

CLIENT / MATTER NO.: *100506-0004*

PATENT APPLICATION FILE

PATENT NO.: _____

ISSUE DATE: _____

INVENTOR(S): *(NEW) CONT DIV CIP REISSUE*

SERIAL NO.: *01924386* FILED *11/5/2000*

TITLE: *The use of Alpha 1-antitrypsin in the treatment of*

emphysema

ASSIGNEE: *Altabris S.p.A.*

RELATED U.S. APPLICATIONS: _____

PRIORITY: *4999*

SPECIAL CLIENT INSTRUCTIONS:

ATTORNEY FILE REVIEW

DATE _____ INIT. _____

DATE _____ INIT. _____

DATE _____ INIT. _____

OFFICE ACTIONS

DUE DATE

RESPONSES

New Pat Appln *10-8-01* *rid 10-5-01*

Due 1/20/02



VISION # 63264

SERIAL #

/M: 100506-00004

CLIENT NAME: *Brachet Bracco Puro*

CLIENT REFERENCE: *9423 V/vmf*

CLIENT NO.: *100506-0004*

MATTER NO.: *100506-0004*